

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 5, 9, 13, and 23 are requested to be cancelled.

Claims 1, 10, and 17 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-4, 6-12, and 14-22 are now pending in this application.

In the office action dated December 16, 2005, the Examiner rejected claims 10-16 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,333,973 (Smith et al.), set forth in the previous office action dated March 24, 2005. Claims 1, 2, 17, and 19-23 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,925,299 (Sofer et al.) Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sofer et al. in view of U.S. Patent Application Publication No. 2003/0061503 (Katz et al.)¹ Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sofer et al. in view of U.S. Patent Application Publication No. 2005/0048958 (Mousseau et al.) Claims 5-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sofer et al. in view of U.S. Patent No. 6,333,973 (Smith et al.) Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sofer et al. in view of U.S. Patent No. 6,625,461 (Bertacchi). Notwithstanding the Examiner's assertions, Applicant respectfully traverses the rejection for the reasons set forth below.

¹ In section 5 of the outstanding office action, the Examiner cited U.S. Patent Application Publication No. 2005/0048958 (Katz et al.) It is believed that the Examiner made a typographical error, and that U.S. Patent Application Publication No. 2003/0061503 (Katz et al.) should have been cited instead.

In response to the Examiner's rejections and in order to clarify the nature of the present invention, Applicant has canceled claims 5, 9, 13, and 23 and amended independent claims 1, 10, and 17 to more particularly describe the message notification and retrieval aspect of the present application. Applicant submits that these amendments more particularly describe how notification messages may be filtered and message parameters may be compared with certain established criteria for retrieving complete messages in order to determine whether or not a notification message should be sent or a complete message should be retrieved.

Regarding the Examiner's rejection of claims 10-16, Applicant respectfully submits that the claims describe a method for receiving the notification as well as the complete messages through distinct first and second communication networks as opposed to distinct first and second communication channels within a single communication network as taught by Smith, as already argued by Applicant in the Amendment and Reply filed September 26, 2005.

Amended claim 1 recites a particular method for complete message delivery to a communication device, where a message notification is parsed to determine a set of parameters pertaining to the complete message, and where that set of parameters is compared to an established set of criteria for retrieving complete messages. Therefore, before a complete message is sent, the set of parameters can be used to determine whether or not the second communication network is capable of, or is preferably configured, to efficiently receive and transmit the complete message to a user. This process advantageously optimizes the transmission of complete messages by reducing, for example, low throughput due to a large complete message that requires a larger bandwidth than is provided by the second communications network. (*See* also paragraphs [44]-[49] of the specification). Independent claim 10 has been similarly amended.

Applicant submits that Sofer et al. does not teach or suggest the use of message parameters pertaining to the complete message for comparing the parameters to established criteria to determine whether or not to retrieve the complete message. Sofer et al. merely teaches using an existing telephone infrastructure 14 or an IP network 36 to send basic message alerts to roaming mobile subscribers. (*See* Abstract, column 6, lines 12-36, column

7, lines 13-33, and column 9, lines 18-40). However, the Examiner asserted that Smith et al. teaches the parsing of parameters and the comparison of those parameters to established criteria. Applicant respectfully disagrees with this position. Smith et al. merely teaches sending message notifications and organizing the message notifications according to certain properties or preferences for display to a user. In particular, column 8, lines 40-45 states that “Each entry in the scrollable list of notification headers identifies a received message and includes the sender’s name 7400 and an identification icon 7500, identifying the type of message. The identification icons include, for example, icons used to identify voice mail, SMS messages, e-mail, and faxes.” (See also FIGS. 7A and 7B). Therefore, Smith et al. does not teach or suggest comparing the parameters to any sort of criteria whatsoever. By contrast, claims 1 and 10 of the present application require that certain retrieval criteria are established and compared to the message parameters. This cannot be likened to simply determining that a certain message is, for example, a fax message, and indicating this message type to a user. As such, Smith et al. does not cure the deficiencies of Sofer et al.

Amended claim 17 recites a particular system, where a message filter is configured to screen a complete message prior to notifying the communication device of the complete message to determine, based upon passing the message filter, whether or not the notification message should be set. As discussed above, such a process allows the system of claim 17 to determine whether or not the second communication network is capable of, or is preferably configured, to efficiently receive and transmit the complete message to a user. (See paragraphs [33]-[39] of the specification).

The Examiner asserted that screening the complete message prior to notification is inherently taught by Sofer et al, citing FIG. 1, 100, column 6, lines 12-15 and lines 36-56. Applicant respectfully disagrees with this position. In particular, Applicant submits that Sofer et al. does not teach or suggest any sort of screening process. As discussed above, Sofer et al. merely teaches using an existing telephone infrastructure 14 or an IP network 36 to send basic message alerts to roaming mobile subscribers. There is no reason for the system of Sofer et al. to screen incoming messages, because notifications are sent out for all incoming messages, regardless of whether or not the second network is capable of efficiently transmitting or handling the complete message. (See column 6, lines 12-56). In addition, FIG. 1 of Sofer et al. shows a prior art system-level telecommunications diagram with no

element 100, nor any suggestion that message screening would inherently occur. Therefore, Sofer et al. fails to anticipate all of the limitations required by claim 17 of the present application.

Because none of the references cited by the Examiner, either separately or in combination with each other, teach all of the limitations required by claims 1, 10, and 17. Applicant submits that independent claims 1, 10, and 17 are patentable over this prior art. Furthermore, because dependent claims 2-4, 6-8, 10-12, and 14-22 are each directly or indirectly dependent upon independent claims 1, 10, and 17, Applicant submits that each of these claims are allowable for at least the same reasons as discussed above.

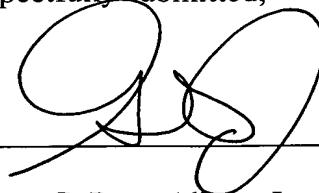
Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1450. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1450. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1450.

Respectfully submitted,

By

A handwritten signature in black ink, consisting of a large, stylized 'G' followed by a smaller 'P' and a 'Jr.' that is partially obscured by the signature's loops.

G. Peter Albert, Jr.
Attorney for Applicant
Registration No. 37,268

Date JUNE 6, 2006

FOLEY & LARDNER LLP
Customer Number: 27433
Telephone: (312) 832-4553
Facsimile: (312) 832-4700